



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/431,833 | 11/02/1999 | JOSEPH PHILLIP BIGUS | IBM/02B | 9272 |

7590 11/13/2003

WOOD HERRON & EVANS LLP
2700 CAREW TOWER
CINCINNATI, OH 45202

EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/431,833 | BIGUS ET AL. |
| | Examiner | Art Unit |
| | Firmin Backer | 3621 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 54-63 and 104-112 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 54-63 and 104-112 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____ .

Response to Request for Reconsideration

This is in response to a request for reconsideration file October 2nd, 2003. Claims 54-63 and 104-112 are being reconsidered in this action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 54-63 and 104-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al (U.S. Patent No. 5,550,145) in view of Tanaka et al (U.S. Patent No 5,905,495)

3. As per claims 54, 60, and 61, Hoffman et al teach a method comprising determining at least one attribute (*biometric sample/information*) related to the unknown party, comparing (*comparing*) the attribute for the unknown party with attributes related to a plurality of known parties (*stored biometric information/sample*), and identifying (*identifying*) the unknown party as the known party having the attribute which most closely matches that of the unknown party and a signal bearing media bearing the program (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*). Hoffman et al fail to teach an inventive concept of identifying an unknown party interacting with an intelligent agent.

However, Tanaka et al teach an inventive concept of identifying an unknown party interacting with an intelligent agent (*see abstract, column 3 lines 8-4 lines 44*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoffman et al's inventive concept to include Tanaka et al inventive concept of identifying an unknown party interacting with an intelligent agent because this would have provided a more secure, productive and adaptive environment for conducting commercial transaction,

4. As per claims 55 and 108, Hoffman et al teach a method of determines a plurality of attributes related to the unknown party, and compares the plurality of attributes for the unknown party with those of the plurality of known parties (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

5. As per claims 56 and 109, Hoffman et al teach a method wherein the comparing step includes the step of accessing a database including a plurality of records, each record associated with a known party and including the plurality of attributes related thereto (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

6. As per claims 57, 104, 105 and 110, Hoffman et al teach a method wherein each of the plurality of attributes has a weighting factor associated therewith, wherein the comparing step calculates an accumulated weighting factor for each known party by summing the weighting factors of the attributes of the known party which match those of the unknown party, and wherein the identifying step identifies the unknown party as the known party with the largest

accumulated weighting factor (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

7. As per claims 58, 106 and 111, Hoffman et al teach a method wherein the unknown party is an intelligent agent configured to conduct electronic transactions, and wherein the plurality of attributes is selected from the group consisting of an agent name, a client name, a bank name, a bank account number, a credit card number, a home base location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

8. As per claims 59, 107, 112, Hoffman et al teach a method, wherein the unknown party is an intelligent agent, and wherein the determining step includes the step of scanning program code for the unknown party to determine attributes thereof (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

9. As per claims 62 and 63, Hoffman et al teach a program product wherein the signal bearing media is transmission recordable type media (*see abstract, fig 1 and 2, column 7 line 50-59,8 line 11-51, 9 line 11-44, 12 line 23-13 line 34, 71 line 5-20, claim 1*).

Response to Arguments

10. Applicant's arguments filed October 2dn, 2003 have been fully considered but they are not persuasive.

a. Applicants argue that the prior art fail to teach an inventive concept where in an intelligent agent interacting with an unknown party. Examiner respectfully disagrees with applicant's characterization of the prior art. In Applicants disclosure and also in the art, an intelligent agent is described as simply a software implemented "assistant" operate to simplify certain complex tasks. Therefore the interaction of unknown party is simply an interaction of an unknown party with a software or simply "agent." Hoffman et al teach tokenless system and method are principally based on a correlative comparison of a unique biometrics sample, such as a finger print or voice recording, gathered directly from the person of an unknown user, with an authenticated biometrics sample of the same type obtained and stored previously. The user tenders an access request directly to the host computer system of the invention, which is operationally interactive with other independent secured computer systems such as VISANET. The computer system would therefore maintain authenticated biometrics data samples for all authorized users of each secured computer system that it services. These data would be cross-referenced by each authorized user. Thus, after identity verification is completed, the security system provides to the user a listing of systems that he is authorized to access, and prompts the user to select the desired network. Thereafter, the requested execution step and information regarding the transaction is forwarded to the selected independent computer network similar to the type of communications sent today between merchants and credit

card companies. Tanaka also teach a communication system having communication terminals connected therein is generally designed so that one of users at the communication terminals can signal to or communicate with the communication terminal of a desired party user on the basis of a terminal address of the party user's communication terminal uniquely allocated thereto. Therefore, *it is impossible for a caller to communicate with such a communication terminal that the caller does not know the party's terminal address*. Although Tanaka is silent with respect to the *expression* intelligent agent, Tanaka it not silent with respect with a user/party interaction with a system or software as describe above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

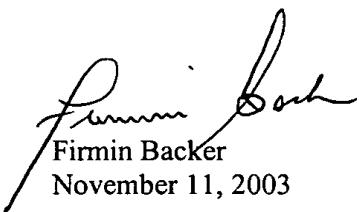
Application/Control Number: 09/431,833
Art Unit: 3621

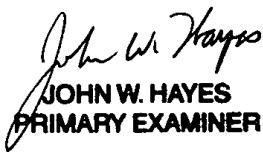
Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


Firmin Backer
November 11, 2003


JOHN W. HAYES
PRIMARY EXAMINER